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19 MAR 2007

In re Application of	:	
Douglas	:	
Application No.: 10/550,036	:	DECISION
PCT No.: PCT/GB04/01185	:	
Int. Filing Date: 18 March 2004	:	ON
Priority Date: 21 March 2003	:	
Attorney Docket No.: 7881.18	:	PETITION
For: Jaw Crusher	:	

This is in response to the petition under 37 CFR 1.47(a) filed on 07 February 2007, which has been treated under 37 CFR 1.47(b).

BACKGROUND

This international application was filed on 18 March 2004, claimed an earlier priority date of 21 March 2003, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 30 September 2004. The 30 month time period for paying the basic national fee in the United States expired at midnight on 21 September 2005. Applicants filed *inter alia* the basic national fee on 21 September 2005.

On 09 August 2006, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration compliant with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(h).

DISCUSSION

Treatment under 37 CFR 1.47(b) is appropriate because the sole inventor has not executed the application. A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known addresses of the inventors, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Regarding **requirement (1)**, the \$200.00 petition fee was paid on 07 February 2007.

Regarding **requirement (2)**, petitioner urges that the absence on the declaration of the signature of inventor Douglas be excused because he allegedly "refuses to execute the declaration." Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands

exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Review of the petition and accompanying papers reveals that petitioner has not provided evidence, of the type described at MPEP 409.03(d), showing that Mr. Douglas in fact refused to execute the declaration after being presented with it and a complete copy of the application papers. Specifically, the evidence (including Mr. Orr's letter dated 14 November 2006) tends to show that a copy of a declaration document directed to this application was sent to Mr. Douglas. However, the evidence does not unambiguously show that he was presented with a complete copy of this particular application. Mr. Orr's letter dated 28 November 2006 indicated that copies of "the three basic PCT cases on which the US filings were made" were being sent to Mr. Douglas, and provided the titles of the applications in question. However, the letter did not identify with adequate specificity that a copy of this particular application was being sent (for instance, by identifying its application number and filing date, to differentiate it from any other application which might share the same title). Since it is not clear that Mr. Douglas refused to execute the declaration (or even that he failed to return an executed oath or declaration after being presented with a complete copy of this particular application along with the oath or declaration), requirement (2) has not been satisfied.

Therefore, it would not be appropriate to conclude on the basis of the present record that requirement (2) has been satisfied.

Regarding **requirement (3)**, the petition includes a statement of the last known address of Paul Douglas. Accordingly, requirement (3) has been satisfied.

Regarding **requirement (4)**, MPEP 409.03(b)(A) states that

The 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP § 324. An inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf. *Staeger v. Commissioner*, 189 USPQ 272 (D.D.C. 1976), *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973). Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).

Petitioner has not filed a declaration naming Mr. Douglas as the sole inventor and signed on his behalf by an appropriate person as defined under MPEP 409.03(b)(A). It is noted that copies of declaration documents are included in the petition as evidence of the contents of certain correspondence allegedly sent to Mr. Douglas, but none of these declarations have been signed on his behalf. As such, requirement (4) has not been satisfied.

Regarding **requirement (5)**, MPEP 409.03(f) states that

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324). An assignment of an application and any "reissue, division, or continuation of said application" does not itself establish an assignment of a continuation-in-part application. *In re Gray*, 115 USPQ 80

(Comm'r Pat. 1956). An assignment to a 37 CFR 1.47(b) applicant for the sole purpose of obtaining a filing date for a 37 CFR 1.47(b) application is not considered an assignment within the meaning of 35 U.S.C. 118 and 37 CFR 1.47(b).

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter. A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Petitioner asserts (in part) that Extec Screens & Crushers Limited ("Extec") is the "assignee of this patent application." However, petitioner has submitted neither an assignment executed by Mr. Douglas, nor pointed out where in the records of the USPTO such an assignment has been recorded (e.g., by reel and frame number). Nor has petitioner presented an acceptable statement under 37 CFR 3.73(b). The petition contends that ownership of the instant application resides with Extec by dint of Mr. Douglas' employment, but no copy of any pertinent employment agreement has been provided. Counsel also has not provided an appropriate legal memorandum demonstrating Extec's alleged proprietary interest in this application. The statements by Ian Frazer English and William McLean Orr do not constitute acceptable legal memoranda because they do not show why title would be awarded to Extec by application of the relevant law to the specific facts of this case, with copies of the relevant evidence and authority attached. As such, requirement (5) has not been satisfied.

Petitioner has not included a showing or statement demonstrating irrevocable harm per requirement (6).

DECISION

The petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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